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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/356,926	07/19/1999	WIM J. VAN OOIJ	19789-008	8477

7590 01/28/2004
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EXAMINER

LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/356,926

Applicant(s)

OOIJ ET AL.



Examiner

Michael La Villa

Art Unit

1775

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12/22/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 22 December 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-6,9,10,12-14,16,17,39 and 40.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: Interview Summary of 1/20/04.

 1/20/04

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments are not satisfactory for overcoming the section 112, first paragraph rejection and the section 103 rejection over Brown of the Office Action mailed on 18 July 2003. Applicant points to the Table at pages 17 and 18 for antecedent support for Claim 40. The subject matter of Claim 40 is volumetric ratios of vinyl silane to bis-silyl aminosilane being in excess of about 9. While one example constitutes a ratio of 9, no examples or discussion pertains to ratios in excess of 9. Hence, there appears to be no support for ratios in excess of 9. The provided example refers to only one pair of vinyl silane and bis-silyl aminosilane compounds. It is unclear where support for the entire breadth of all claimed compounds lies. It is remarked that this is not an enablement rejection, but rather a new matter rejection. The new matter rejection is maintained. Applicant has filed a declaration by Inventor van Ooij in conjunction with traversing the section 103 rejection over Brown. The declaration describes three experiments. In the first experiment, the claimed compositions were surprisingly observed to perform less well than those comprised of BTSE. This poor performance was attributed to stale chemicals and an improper curing regime. In Experiment 2, according to declarant's conclusion at page 6, the presented evidence demonstrated that BTSE and A-1170 compositions under the utilized conditions provided comparable performance. In Experiment 3 the presented evidence demonstrated that coating with the A-1170 containing composition was superior to coating with a BTSE containing composition under the utilized conditions. However, the A-1170 containing composition is not encompassed by the presently claimed compositions. The volumetric ratio in Experiment 3 is 1:2, which is less than the claimed 1:1 or greater. Applicant's presented evidence in this declaration, therefore, does not appear to prove unexpected results for the breadth of the claimed invention for the invention as presently claimed. Applicant's arguments and previously presented evidence, for the reasons given previously, also do not demonstrate unexpected results or nonobviousness over Brown. Hence, the rejection over Brown is maintained.

Labla
1/20/04